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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
	:	
Mark PETERS et al.	:	Confirmation Number: 6041
	:	
Application No.: 10/675,503	:	Group Art Unit: 3692
	:	
Filed: September 30, 2003	:	Examiner: B. Fields
	:	

For: DYNAMIC PROCESSING OF PAYMENT REQUESTS FOR MOBILE COMMERCE
        TRANSACTIONS

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed April 8, 2008, and

in response to the Examiner reopening prosecution in the Office Action dated April 30, 2008,

wherein Appellants appeal from the Examiner's rejection of claims 1-12.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on September

30, 2003, at Reel 014572, Frame 0992.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-12 are pending and three-times rejected in this Application. It is from the multiple rejections of claims 1-12 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated April 30, 2008 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1   Referring to Figure 2 and to independent claim 1, a mobile commerce system is

2   disclosed. The system includes a plurality of mobile server wallets 230, a proxy server 240, and

3   a filter plug-in 270. Each of the wallet 230 have an association with a corresponding subscriber

4   210 in a wireless service provider network (page 7, lines 13-17). The proxy server 240 is

5   disposed in the wireless service provider network (page 7, lines 21-22). The filter plug-in 270 is

6   coupled to the proxy server 240 and is configured to intercept selected payment messages 290

7   flowing through the proxy server 240 (page 8, lines 1-8) and to route the payment messages 290

8   to selected ones of the mobile server wallets 230 (page 8, lines 9-11).

9   Referring to Figure 3 and to independent claim 5, a method for processing mobile

10   commerce transactions in a wireless service provider network is disclosed. In blocks 320, 330,

11   messages flowing between merchants and subscribers to the wireless service provider network

12   are filtered to identify specific payment messages associated with specific subscribers in the

13   wireless service provider network (page 9, lines 4-8). In block 350, filtered ones of the payment

1   messages are routed to specified mobile server wallets associated with the specific subscribers

2   (page 9, lines 9-10).

3   Referring to Figure 3 and to independent claim 9, a machine readable storage having

4   stored thereon a computer program for processing mobile commerce transactions in a wireless

5   service provider network is disclosed. The computer program comprising a routine set of

6   instructions for causing the machine to perform the following steps. In blocks 320, 330,

7   messages flowing between merchants and subscribers to the wireless service provider network

8   are filtered to identify specific payment messages associated with specific subscribers in the

9   wireless service provider network (page 9, lines 4-8). In block 350, filtered ones of the payment

10   messages are routed to specified mobile server wallets associated with the specific subscribers

11   (page 9, lines 9-10).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-12 were rejected under 35 U.S.C. § 103 for obviousness based upon Suzuki et al., U.S. Patent Publication No. 2002/0032616 (hereinafter Suzuki), in view of Steed et al., U.S. Patent Publication No. 2002/0107755 (hereinafter Steed).

VII. ARGUMENT

1 **THE REJECTION OF CLAIMS 1-12 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED**

2 **UPON SUZUKI IN VIEW OF STEED**

3   For convenience of the Honorable Board in addressing the rejections, claims 3-12 stand

4 or fall together with independent claim 1; and claim 2 stands or falls alone.

5

6   As is evident from Appellants' previously-presented comments during prosecution of the

7 present Application and from Appellants' comments below, there are questions as to how the

8 limitations in the claims correspond to features in the applied prior art. In this regard, reference

9 is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the

10 following is stated:

11   (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
12   answer is <u>required to include</u>, under appropriate headings, in the order indicated, the following
13   items:
14   ...
15   (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions
16   as to how limitations in the claims correspond to features in the prior art even after the
17   examiner complies with the requirements of paragraphs (c) and (d) of this section, the
18   examiner <u>must</u> compare at least one of the rejected claims <u>feature by feature</u> with the
19   prior art relied on in the rejection. The comparison <u>must</u> align the language of the claim
20   side-by-side with a reference to the specific page, line number, drawing reference
21   number, and quotation from the prior art, as appropriate. (emphasis added)
22
23 Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's

24 Answer, the Examiner is required to include the aforementioned section in the Examiner's

25 Answer.

26

27   As noted in the First Appeal Brief dated April 8, 2008, the Examiner failed to specifically

28 identify the teachings being relied upon in the rejection as required under with 37 C.F.R. §

1   1.104(c).[1] Previously, the Examiner rejected the claims under 35 U.S.C. § 102 for anticipation

2   based upon Suzuki, whereas in the current rejection the Examiner is relying upon Suzuki to teach

3   most of the claim limitations and Steed to teach "a proxy server disposed in said wireless service

4   provider (see lines 3-4 on page 4 of the Third Office Action). However, despite citing different

5   and/or additional passages within Suzuki, the Examiner's analysis in the Third Office Action still

6   fails to clearly explain the pertinence of Suzuki.

7

8   "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of

9   presenting a *prima facie* case of obviousness."[2] The legal conclusion of obviousness is based on

10   underlying findings of fact including the scope and content of the prior art, the differences

11   between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.[3]

12   "Secondary considerations such as commercial success, long felt but unsolved needs, failure of

13   others, etc., might be utilized to give light to the circumstances surrounding the origin of the

14   subject matter sought to be patented."[4] Therefore, to properly make a finding of obviousness, a

15   comparison between the applied prior art and the claims at issue must be made to ascertain the

16   differences between what is being claimed and the teachings of the applied prior art. Moreover,

17   before making a proper comparison between the claimed invention and the prior art, the

18   language of the claims must first be properly construed.[5]

---

[1] 37 C.F.R. § 1.104(c) provides:

        In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

[2] In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

[3] KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

[4] Id. (quoting Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17–18 (1966)).

[5] See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question,

1

2   <u>Claim 1</u>

3   On pages 3 and 4 of the Third Office Action, the Examiner asserts that Suzuki teaches the

4   claimed filter plug-in coupled to the proxy server. To teach these limitations, the Examiner

5   asserted that Suzuki teaches "plug-in software in order to route messages regarding payment

6   transaction within the system." Although the Examiner asserts that the plug-in software is

7   identical to the claimed filter plug-in, the Examiner has failed to provide a claim construction for

8   the claim language at issue.

9

10   As noted by Appellants on page 9, lines 4-6 of the First Appeal Brief, a filter routes

11   certain messages based upon a selection criteria. The plug-in software used to route messages,

12   as taught by Suzuki, does not teach the claimed filtering. Although a router and a filter share

13   certain similarities, they are not identical. As the name implies, a router routes messages.

14   Although a filter can also route messages, the messages being routed are first filtered. As

15   claimed, the filter plug-in is "configured to <u>intercept</u> <u>selected</u> payment messages flowing through

16   the proxy server." As this limitation implies, messages flow through the proxy server and where

17   certain <u>selected</u> messages are <u>intercepted</u> (and then routed) others are not. The Examiner,

18   however, has not established that the plug-in software described by Suzuki has these filtering

19   capabilities. Thus, the Examiner has failed to properly characterize the scope and content of

20   Suzuki.

21

"what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); <u>see</u> <u>Gechter v. Davidson</u>, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

1   As noted on pages 6 and 7 of the First Appeal Brief, the Examiner has failed to factually

2   establish that Suzuki teaches the claimed plurality of mobile server wallets have an association

3   with "a corresponding subscriber in a wireless service provider network," as claimed. Upon

4   reviewing the Examiner's statement of the rejection on page 3 of the Third Office Action,

5   Appellants are still unclear as to exactly what features within Suzuki the Examiner is relying

6   upon to teachings these limitations.

7

8   The Examiner's obviousness analysis with regard to Steed is found in the second and

9   third full paragraphs on page 4 of the Third Office Action and are reproduced below:

10   Steed, in a similar environment, discusses a proxy server disposed [with] in [a] said
11   wireless service provider network (Steed: Abstract; Page 1, Paragraph 0003-Page 2, Paragraph
12   0014).
13   At the time of the invention it would have been obvious to one of ordinary skill in the art
14   to modify the method of Suzuki for a relay server method and payment system with the disclosure
15   of Steed for a server based electronic wallet system by including a proxy server for the purpose of
16   automatically completing/filling-in forms relating to purchasing, etc. on behalf of a customer
17   (Steed: Page 1, Paragraphs 0003-0013) for the benefit of speeding up the process as well as
18   prevention of input errors.
19

20   At the outset, Appellants are unclear where Steed teaches that the wallet proxy 14

21   (presumably corresponding to the claimed proxy server although the Examiner's analysis is

22   unclear as to the particular teachings being relied upon) is disposed within a wireless service

23   provider network, as claimed. Paragraph [0020] of Steed states that the wallet proxy 14 is

24   software that runs on a server connected to WAP gateway 12 or the same server as the WAP

25   gateway 12. However, Appellants have not been able to find a teaching that the wallet proxy is

26   "disposed in said wireless service provider network," as claimed. Thus, the Examiner has also

27   failed to properly characterize the scope and content of Steed.

28

1   As to the Examiner's alleged common sense rationale for the combination (i.e., "for the

2   purpose of automatically completing/filling-in forms relating to purchasing, etc. on behalf of a

3   customer"), these alleged benefits are related to use of the electronic wallet (i.e., wallet server

4   17) and not necessarily to the use of the wallet proxy 14. However, Suzuki already teaches the

5   use of an electronic wallet. Thus, the Examiner's alleged common sense rationale for the

6   proposed combination would not have rendered the combination obvious since the benefits

7   allegedly resulting from this combination are already obtained through the teachings of Suzuki.[6]

8

9   Claim 2

10   In the first full paragraph on page 10 of the First Amendment, Appellants presented the

11   following arguments. Dependent claim 2 recites, in part, "a plurality of profiles

12   communicatively linked to said filter plug-in," and to teach this limitation the Examiner cited

13   paragraph [0030]. However, this passage (previously reproduced above) is silent as to a filter

14   plug-in and as to profiles that "[specify] a merchant configured to engage in mobile commerce

15   transactions through said wireless service provider network," as claimed. In this regard,

16   Appellants note that the Examiner's analysis fails to establish why the Examiner believes

17   paragraph [0030] identically discloses this limitation.

18

19   Although the Examiner did not directly respond to these arguments in the Second Office

20   Action or the Third Office Action, the Examiner did assert the following in the first full

21   paragraph on page 3 of the Third Office Action:

---

[6] See the non-precedential opinion of Ex parte Rinkevich, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

1   Furthermore, the Examiner notes that it is old and well known in the art [of
2   wireless/mobile commerce, etc.] to preferably create a system that attaches a profile which would
3   correspond to each transaction of a filter plug-in in order to monitor the transactional history of
4   exchanges which occur via the system.

5

6   Not only is the Examiner's allegation as to what is "old and well known in the art" not supported

7   by substantial evidence, the Examiner's allegation does not even correspond to the language of

8   the claims. As claimed, the profiles specify a merchant configured to engage in mobile

9   commerce transactions through the wireless service provider network. However, this is different

10   than what the Examiner asserts is old and well known in the art. Moreover, although the

11   Examiner asserts what is "old and well known in the art" with regard to a filter plug-in, as noted

12   above, the Examiner has not even established that the applied prior art teaches the claimed filter

13   plug-in.

14

15   <u>Conclusion</u>

16   Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection

17   under 35 U.S.C. § 103 based upon the applied prior art is not viable. Appellants, therefore,

18   respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 11, 2008

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VIII. CLAIMS APPENDIX

1. A mobile commerce system comprising:

a plurality of mobile server wallets each wallet having an association with a corresponding subscriber in a wireless service provider network;

a proxy server disposed in said wireless service provider network; and,

a filter plug-in coupled to said proxy server and configured to intercept selected payment messages flowing through the proxy server and to route said payment messages to selected ones of said mobile server wallets.

2. The mobile commerce system of claim 1, further comprising a plurality of profiles communicatively linked to said filter plug-in, each of said profiles specifying a merchant configured to engage in mobile commerce transactions through said wireless service provider network, said filter plug-in having a further configuration for routing said payment messages to said selected ones of said mobile server wallets when a source of said payment messages matches a merchant identity specified in at least one of said profiles.

3. The mobile commerce system of claim 1, wherein individual ones of said mobile server wallets are disposed in at least one of an Internet service provider server, said wireless service provider network server, a merchant server, a financial institution server and a portal server.

4. The mobile commerce system of claim 2, wherein at least one of said profiles further comprises a specification of a markup language able to be processed in said filter plug-in.

5. A method for processing mobile commerce transactions in a wireless service provider network, the method comprising the steps of:

filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network; and,

routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers.

6. The method of claim 5, further comprising the steps of:

consulting filters which specify specific ones of said merchants;

monitoring message traffic flowing from said merchants; and,

intervening in purchase transactions originating in said merchants.

7. The method of claim 5, wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless service provider network.

8. The method of claim 5, wherein said routing step comprising routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers and selected by said specific subscribers.

9. A machine readable storage having stored thereon a computer program for processing mobile commerce transactions in a wireless service provider network, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network; and,

routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers.

10. The machine readable storage of claim 9, further comprising the steps of:

consulting filters which specify specific ones of said merchants;

monitoring message traffic flowing from said merchants; and,

intervening in purchase transactions originating in said merchants.

11. The machine readable storage of claim 9, wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless service provider network.

12. The machine readable storage of claim 9, wherein said routing step comprising routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers and selected by said specific subscribers.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.